

Remarks

The Examiner withdrew the rejections with respect to EP 1 037 041 A2 but maintained the rejections of claims 20, 21, 24-28, 30, 31, 33, and 34 under 35 USC §103 as being obvious over U.S. Patent No. 6,682,638 to Prohaska in view of U.S. Patent No. 4,272,353 to Lawrence or U.S. Patent No. 6,319,293 to Debe with or without Aldrich chemical catalog. Based on the following remarks, Applicants submit all claims should be allowed.

All claims relate to an ionomer membrane that is dry during the steps of providing the at least one opening in the substrate, placing the electrode proximate to the at least one opening, contacting the dry ionomer membrane to the substrate and electrode, providing at least one hole in the ionomer membrane, and aligning the at least one hole with the at least one opening for defining a gas passage.

As stated in the outstanding Office Action, Prohaska is relied upon for teaching the use of an opening 6 that extends through both a portion of the substrate 10 and the ionomer membrane 5 thereby defining a passage (paragraph 3 of the Office Action). Also as stated in the Office Action, the Examiner is relying upon this teaching in Prohaska to show Applicants' limitation of a hole in the ionomer membrane that is aligned with at least one opening in the substrate (paragraph 3). With respect to claims 33 and 34, the Examiner relies upon Prohaska for teaching a reservoir 9 and for the reservoir to be obviated if the humidity in the atmosphere is sufficient.

Because Prohaska and the present application were commonly owned at the time the invention of the present invention was made, Prohaska cannot be used in a rejection under 35 USC §103(a) against the present application. MPEP sec. 706.02(I).

Because Prohaska is disqualified as art in a rejection under 35 USC §103, Prohaska cannot be used to show the above teaching, namely the step of aligning at least

one hole in the ionomer membrane with at least one opening in the substrate. Moreover, Prohaska cannot be used to show a reservoir. Because Prohaska is disqualified, a combination of the remaining references must show this claimed limitation in order to arrive at a rejection under 35 USC §103. However, neither Lawrence, Debe, nor Aldrich teach or suggest, and the Examiner does not rely upon any of these references in the outstanding Office Action for teaching or showing, the step of aligning at least one hole in the ionomer membrane with at least one opening in the substrate, a combination of these references still does not result in this claimed limitation. Hence, even assuming that the references may be combined, and Applicants' are not conceding this, the resulting combination lacks the claimed the step of aligning at least one hole in the ionomer membrane with at least one opening in the substrate absent modification to the combination.

Debe teaches a three layered assembly of a membrane with an electrode on both sides of the membrane (This is a membrane electrode assembly (MEA), or an electrode-conductive membrane-electrode (see Abstract, Summary, Detailed Description)). There is no discussion whatsoever of providing at least one opening in the substrate, providing at least one hole in the ionomer membrane, placing the electrode proximate to the at least one opening, or aligning the at least one hole with the at least one opening for defining a gas passage. Not one of these four limitations are shown in Debe, nevermind all four of them which are recited in all of Applicants' pending claims. Therefore, not only does Debe lack the teaching for which Prohaska is relied upon, but Debe also lacks other claimed limitations.

Likewise, Lawrence lacks any teaching or suggestion for the membrane to be dry during the steps of providing the at least one opening in the substrate, placing the electrode proximate to the at least one opening, contacting the dry ionomer membrane to the substrate and electrode, providing at least one hole in the ionomer membrane, and aligning the at least one hole with the at least one opening for defining a gas passage.

Not one of these five limitations are shown in Lawrance, nevermind all five of them which are recited in all of Applicants' pending claims. Therefore, not only does Lawrance lack the teaching for which Prohaska is relied upon, but Lawrance also lacks other claimed limitations.

For a modification to be proper, there must be teaching or suggestion in the cited art in order to provide motivation for one skilled in the art to make the modification. Absent such teaching or suggestion, one skilled in the art would not have the motivation to make the suggested modification and, therefore, such modification in the absence of these requisite teachings or suggestions is improper. As discussed above, the none of the references teach or suggest, and therefore neither does the combination of references, a membrane that is dry during the steps of providing the at least one opening in the substrate, placing the electrode proximate to the at least one opening, contacting the dry ionomer membrane to the substrate and electrode, providing at least one hole in the ionomer membrane, and aligning the at least one hole with the at least one opening for defining a gas passage.

Without these requisite teachings or suggestions, there is no motivation to properly modify the cited art under 35 USC §103 and the rejections should be withdrawn. Based on the foregoing, Applicants' submit that all claims are in condition for allowance.

Respectfully submitted,

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